

III. REMARKS

1. Applicant appreciates the Examiner's indication of allowable subject matter in claims 10-11, 18-19, 21-22, 27, 31, 35 and 39. It is respectfully submitted that the amendments to the claims and the remarks herein should place all of the claims pending in this application in a condition for allowance.

2. Drawing Objection under 37 CFR 1.83(a)

It is respectfully submitted that Figure 3 is in compliance with all of the requirements of 37 CFR 1.83(a) and that all of the necessary structural details as described in the specification are present. MPEP §608.02(d) states that any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. The Examiner has objected to Figure 3 because it fails to show a legend. Figure 3 shows a device (20), a display (21), a keypad (22), and function keys (23), which may represent different functions, based on what is shown on the display (21). It is respectfully submitted that the drawing is correctly and sufficiently labelled according to what is described in the specification.

However, to expedite prosecution of this application, a revised Figure 3 is being submitted herewith.

Therefore, the objection should be withdrawn.

3. Claim Rejection under 35 USC 112, first paragraph, written description

It is respectfully submitted that the subject matter of claims 1-23, 41 and 42 are sufficiently described in the specification. 35 USC 112, first paragraph requires that the description in the specification be sufficient as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed. The Examiner has rejected claims 1-23, 41, and 42 under 35 USC 112, first paragraph, saying that these claims contain subject matter which was not sufficiently described in the specification. These claims recite a "plurality" of modes or forms of communication that can be employed in a selected response. It is respectfully

submitted that this subject is sufficiently described in the specification on page 4, lines 25-28, which states, "said reply being on eof the following: a voice message, an e-mail message, a facsimile, an SMS message in the form of a character string. This describes a plurality of modes of communication which were well known in the relevant art at the time of filing, and as such, should provide sufficient written description to satisfy the requirements of 35 USC 112, first paragraph. Therefore, the rejection should be withdrawn.

4. Claim Rejection under 35 USC 112, second paragraph

Claims 1, 20, 23-25, 29, 33 and 37 have been amended in order to correct antecedent basis issues and to overcome the Examiner's rejection under 35 USC 112, second paragraph. It is respectfully submitted that these claims are no longer indefinite, and the rejection should be withdrawn. Claims 2-19, 21, 22, 26-28, 30-32, 34-36, 38-42 should be also allowable at least by reason of their respective dependencies.

Claims 20-23 have been amended in order to recite only one "reply". It is respectfully submitted that these claims are no longer indefinite and the rejection should be withdrawn. Claims 21, 22 and 42 should also be allowable by reason of their dependencies.

5. Double-Patenting Rejection

A Terminal Disclaimer in compliance with 37 CFR 1.321(c) is being filed concurrently herewith, over the conflicting US Patent 6.301,338, to overcome the obviousness-type double patenting rejection. These applications share a common owner.

6. Rejections under 35 USC §103(a)

Claims 1, 7-9, 12-13, 20, 23-26, 29, 30, 33, 34, 37 and 38 are not unpatentable over Mizikovsky in view of Kang under 35 USC §103(a).

Mizikovsky deals with the subject matter of a mobile terminal coupled to various accessory devices and operating in cellular communication system, wherein, in response to an incoming call, the mobile terminal can address a response to a selectable one of the accessory devices.

The examiner notes that Mizikovsky does not teach that a portable device, acting exclusively, sends a response to a caller via a selected accessory device, nor that such an accessory device is integrated with the mobile terminal. The examiner relies on Kang to provide the missing teaching. The examiner notes that Kang discloses construction of a telephone answering machine integrated into a radio telephone. In so far as the examiner's position is understood, the examiner appears to state that, since Kang is able to integrate an answering machine into a common structure with a radio telephone, then it is obvious to integrate the several accessory devices of Mizikovsky into a single portable device.

The foregoing position of the examiner is traversed respectfully because it is believed that a combination of some form of electronic device with a radio telephone does not, by itself, mean that all forms of electronic devices can be combined with radio telephones.

For example, with respect to claim 23, the teaching that - - the portable terminal is capable of sending a reply in any one of a plurality of modes of response, irrespectively of which of the plurality of modes of response is employed in a selected response - - is clearly absent in Kang who discloses only one device (answering machine) integrated with the radio telephone. In Mizikovsky, the accessory devices are separate from the radio telephone. Thus, there would be no motivation to combine these references for rejection of the claims, and there is a clear distinction between the teachings of the cited art and the claimed subject matter, as may be appreciated from the following argument.

It is noted that all of the rejections are based on at least the combination of Mizikovsky with Kang, and wherein for rejections of some of the claims, additional references are combined with Mizikovsky and Kang. With respect to the rejections of the independent claims, all of which are rejected on the combination of Mizikovsky with Kang, the examiner cites features of Kang, concerning the portability or mobility of a telephone, that are not compatible with, and thus not supported by a dictionary reference.

According to the cited dictionary, a car phone is a *cellular* phone "*installed*" in a vehicle. The dictionary also says that there are four types of *cellular* phones: mobile, transportable, portable and handheld. From this the Examiner somehow draws the conclusion that a car phone would be portable.

The conclusion is logically invalid, because in general if we say that A is one type of C, and that there are known four categories M, T, P, and H of C, that still does not tell, whether A can appear in all four categories. Even more convincingly, if something is "*installed*" in a vehicle, it can hardly be portable.

In addition to the foregoing matter of portability or mobility of the telephone, there is a further issue that must be addressed for invalidating the examiner's position that the claims are obvious.

It appears that the Examiner fails to address, in the present Office Action, the Applicant's argument against a finding of obviousness in light of Mizikovsky and Kang, which argument appears in the response to the previous Office Action (beginning at the middle of page 14). Let us reiterate this last part of the response with slightly different words.

The point is that there is no combination, obvious or not, which can be produced from the disclosures of Kang and Mizikovsky to give a portable device that would be capable of selecting the response from a plurality of forms of communication and, furthermore, be capable of sending the response selected from the plurality of forms of communication exclusively through its (the portable device) own actions.

The clear and unambiguous teaching of Mizikovsky is that, to obtain a plurality of forms of communication, there is need to employ a range of auxiliary devices. Employment of the range of auxiliary devices clearly makes the combined aggregate apparatus non-portable.

The teaching of Kang is that, to construct a car phone with an integrated but otherwise conventional telephone answering machine, this may be accomplished by building the answer machine on an option board that is then installed into the telephone apparatus. However, such construction will only provide a single form of communication to choose from. Thus, there is no way of combining the teachings of Mizikovsky and Kang to provide a resulting device which meets the presently claimed limitation "plurality of forms of communication", unless one were to employ the multitude of auxiliary devices of Mizikovsky.

Accordingly, claims 1, 7-9, 12-13, 20, 23-26, 29, 30, 33, 34, 37 and 38 are not unpatentable over Mizikovsky in view of Kang under 35 USC §103(a).

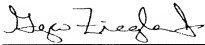
7. Claim 14 is not unpatentable over Mizikovsky in view of Kang further in view of Villa-Real (US Patent No. 4,481,382) under 35 USC §103(a) at least by reason of its dependency.

8. Claims 15-17 are not unpatentable over Mizikovsky in view of Kang and further in view of Wolff et al. (US Patent No. 5,327,486) ("Wolff") under 35 USC §103(a) at least by reason of their respective dependencies.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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